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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,398	11/14/2000	Scott C. Harris	BIODONGLE/SCH	8991

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EXAMINER

MAHMOUDI, HASSAN

ART UNIT PAPER NUMBER

2175

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/712,398

Applicant(s)

HARRIS, SCOTT C.

Examiner

Tony Mahmoudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19 and 21 is/are rejected.
- 7) ☒ Claim(s) 18 and 20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Specification

1. The arrangement of the disclosed application does not conform with 37 CFR 1.77(b).

Section headings should appear in uppercase format. Appropriate corrections are required based on the guidelines provided below:

2. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.

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- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Objections

3. Claims 2-5 and 18 are objected to because of the following informalities:

Claim 2 must end with a period in line 4. Correction is required.

Claims 3-5 are objected to for being dependents from objected to dependent claim 2.

In claim 18, line 4, "in in" should be changed to --in--. Correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3-5 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "said software" in line 4. There is insufficient antecedent basis for these limitations in the claim.

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Claims 4-5 are rejected under 35 U.S.C. 112, second paragraph, as being dependents from rejected dependent claim 3.

Claim 9 recites the limitation “the specified license” in line 4. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-2, 6-7, and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by

Applebaum (U.S. Publication No. 2002/0044655.)

As to claim 1, Applebaum teaches a method (see Abstract), comprising:

storing encrypted information associated with a computer program (see paragraphs 0040-0041, where “computer program” is read on “application”);

obtaining personal information as part of a startup sequence for the computer program (see Abstract, and see paragraphs 0052 and 0056); and

reading the encrypted information (see figure 8), decrypting information contained therein to obtain decrypted information (see paragraph 0022), and comparing the personal information with the decrypted information (see page 9, claim 42); and allowing the computer program to run normally only if the personal information agrees with the decrypted information in a specified way (see pages 8-9, claim 36, where “allowing the computer program to run normally” is read on “allowing access to the distributed productivity environment”).)

As to claim 2, Applebaum teaches wherein the personal information is biometric information (see Abstract), and the comparing comprises comparing the biometric information with other biometric information in the encrypted information (see paragraph 0052.)

As to claim 6, Applebaum teaches the method further comprising determining if a biometric reader is attached to a port (see paragraph 0048), and wherein the program is only allowed to run if the biometric reader is attached to the port (see paragraph 0047.)

As to claim 7, Applebaum teaches the method further comprising allowing the software to run in a limited exception mode without establishing that the personal information agrees with the decrypted information (see pages 8-9, claim 36.)

As to claim 15, Applebaum teaches a system (see Abstract, and see paragraph 0008), comprising:

in a computer (see figures 10 and 11, and see paragraphs 0043 and 0048), run an operating system (see paragraph 0039), which includes an ability to run an associated program (see paragraph 0041);

at least one port, associated with the computer, the port capable of receiving at least one vertebral device thereon (see figure 11); and

a user interface, associated with the computer (see paragraph 0052), receiving a command to run a specified program, and operating to decrypt reference biometric information associated with the specified program (see paragraphs 0022, and 0041), compare currently-obtained biometric information with the reference biometric information (see paragraph 0042), and allows the program to run in a specified way only when the currently-obtained biometric information matches the reference biometric information (see pages 8-9, claim 36, where “allowing the computer program to run normally” is read on “allowing access to the distributed productivity environment”.)

As to claim 16, Applebaum teaches wherein the operating system operates to first detect whether a biometric reading device is attached to the port (see paragraph 0048), and then detect whether biometric information has been received from the biometric reading device, the program being allowed to run in the specified way only when both the biometric reading

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device is attached, and biometric information which is received matches the reference biometric information (see paragraphs 0048 and 0052.)

As to claim 17, Applebaum teaches wherein the operating system decrypts the reference biometric information (see paragraph 0022.)

8. Claims 8-14, 19 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Brody (U.S. Publication No. 2001/0051928.)

As to claim 8, Brody teaches a method (see Abstract), comprising:

requesting a computer system to install a specified computer program (see figure 3, and see paragraphs 0063 and 0082);

determining whether the computer program is verified for installation (see paragraph 0023);

obtaining a reference biometric information from the authorized user (see paragraph 0094); and

thereafter allowing the program to run normally only when biometric information is obtained which matches the reference biometric information (see paragraph 0153.)

As to claim 9, Brody teaches the determining comprises determining if the specified license has already been used for another installation (see paragraphs 0023, 0058, and 0059.)

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As to claim 10, Brody teaches wherein the determining uses a specified unique code that was distributed with the program, and determines from a server whether the unique code has already been used for an installation (see paragraphs 0010, 0015, 0019, and 183.)

As to claim 11, Brody teaches the method further comprising, after determining that the installation is authorized, sending the reference biometric information to a server (see paragraph 0098.)

As to claim 12, Brody teaches the method further comprising, at the server, encrypting the reference biometric information (see paragraph 0152), and returning encrypted biometric reference information which is stored with the program, and which is used by the allowing (see page 23, claim 9, where “biometric reference information” is read on “personalization” and “stored within the program” is read on “within the information stream”).

As to claim 13, Brody teaches wherein the allowing retrieves encrypted biometric information (see page 23, claim 9), decrypts the biometric information (see paragraph 152), and allows the program to run normally only if the decrypted biometric information matches a currently entered biometric information (see paragraph 0153.)

As to claim 14, Brody teaches wherein the reference biometric information is encrypted at the server using a private key of a public key-private key pair, and the reference biometric

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information is decrypted when software is to be run, using the public key corresponding to the private key (see paragraph 0152.)

As to claim 19, Brody teaches a computer readable media (see paragraph 0062), containing instructions (see paragraph 0083) causing the computer to:

detect a request to run a specified program (see figure 3, and see paragraphs 0063 and 0082);

obtain current biometric information (see paragraph 0094);

decrypt an encrypted reference information including reference biometric information therein, and obtaining reference biometric information therefrom (see paragraph 0152);

compares the reference biometric information with the current biometric information (see paragraph 0153); and

allow the specified program to run into specified way only when the reference biometric information matches the current biometric information (see paragraph 0153.)

As to claim 21, Brody teaches wherein the specified way is an unrestricted run which does not detect a number of other executions or operations of the program (see paragraphs 0097 and 0099.)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applebaum (U.S. Publication No. 2002/0044655) in view of Brody (U.S. Publication No. 2001/0051928.)

As to claim 3, Applebaum teaches the method further comprising encrypting the biometric code at the server (see paragraph 0009) and returning an encrypted sequence to the software as the encrypted information (see figure 4, and see paragraph 0018.)

Applebaum does not teach installing the computer program by entering a biometric code, sending the biometric code to a server.

Brody teaches a method of personalizing published software (see Abstract), in which he teaches installing the computer program by entering a biometric code, sending the biometric code to a server (see figure 2, and see paragraph 147.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Applebaum to include installing the computer program by entering a biometric code, sending the biometric code to a server.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Applebaum by the teaching of Brody, because installing the computer program by entering a biometric code, sending the biometric code to a server, would offer personalized installation of the software for remoter clients within a distributed network/system.

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As to claim 4, Applebaum as modified teaches wherein the encrypting uses a private key at the server (see Applebaum, paragraph 0042), and the decrypting verifies a signature of the private key (see Applebaum, paragraph 0052.)

As to claim 5, Applebaum as modified teaches wherein the encrypting uses a private key at the server (see Applebaum, paragraph 0042), and the decrypting uses a public key included as a part of the computer program (see Applebaum, paragraph 0042, and see page 7, claim 20.)

Allowable Subject Matter

11. Claims 18 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record, Applebaum (U.S. Publication No. 2002/0044655) and Brody (U.S. Publication No. 2001/0051928), do not disclose, teach, or suggest the claimed limitations of (in combination with all other features in the claim):

wherein the operating system determines a time and current biometric information is obtained, and compares the time with the current time, and allows the program to run in the

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specified way only when the time is within a specified interval of the current time, as claimed in claim 18.

The prior art of record, Applebaum (U.S. Publication No. 2002/0044655) and Brody (U.S. Publication No. 2001/0051928), do not disclose, teach, or suggest the claimed limitations of (in combination with all other features in the claim):

wherein the compares also compares a time and current biometric information was obtained with a current time, and allows the specified program to run in the specified way only man the time is within a specified interval of the current time, as claimed in claim 20.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of art with respect to methods and systems of users' personal information and users' profiles in a biometric information verification system in general:

Patent/Pub. No.	Issued to	Cited for teaching
US 6,484,260	Scott et al.	Personal identification system using hand-held devices.
US 2001/0018660	Sher	Electronic biometric data implementation in ticketing.
US 2003/0131235	Wheeler et al.	Entity access authentication using biometric data.

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14. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Tony Mahmoudi whose telephone number is (703) 305-4887. The examiner can normally be reached on Mondays-Fridays from 08:00 am to 04:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doy Popovici, can be reached at (703) 305-3830.

tm

September 5, 2003



SAM RIMELL
PRIMARY EXAMINER